

Remarks

Claims 1-17, 19-27, 29-31, 33-40 and 42-45 are pending in the application. Claims 1-17, 19-27, 29-31, 33-40 and 42-45 were rejected. Claims 1-9, 12-17 and 43 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,720,519 (Lui *et al.*). Claims 10-11, 19-27, 29-31, 33-40, 42 and 44-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lui *et al.* ('519) and further in view of U.S. Patent No. 6,621,045 (Lui *et al.*) and U.S. Patent Application Publication No. US 2002/0170891 A1 (Boyle *et al.*). No claims were listed as being objected to and no claims were allowed. By the foregoing amendment, claim 19 is amended. No new matter is presented.

Specification

The Amendment Accompanying RCE filed on July 28, 2006 amended claims 1, 19, 31 and 42 and provided arguments traversing the examiner's rejections in view of the amended claims. In this Office Action, the examiner objected to the July 28, 2006 amendment under 35 U.S.C. §132(a) asserting that the July 28, 2006 amendment introduced new matter into the disclosure. Upon perusing the amendment, the objection apparently was directed to amended claim 19 which included the word "loop" after "diagnostic feedback". The word "loop" does not appear in the specification. Applicants respectfully disagree with the examiner that the inclusion of the word "loop" following feedback is new matter since the use of diagnostic feedback, as taught by the invention, requires a return of measured information which is a control loop. This amendment amends claim 19 by deleting the word "loop".

The Applicants thank the examiner for her time during a telephonic interview on January 12, 2007. The purpose was to understand why the same exact rejections made in the previous Office Action were repeated in this Office Action. A proposed Amendment After Final, amending claims 1, 19, 31 and 42 was not filed since the examiner said during a telephonic discussion in July 2006, that amendments to the claims would raise new issues. In response, the Applicants filed an RCE in conjunction with the aforementioned July 28, 2006 Amendment Accompanying RCE anticipating new issues raised by the claim amendments necessitating a new search.

Even though the new matter objection was to claim 19 (as-amended), which would only affect dependent claims 20-27, 29 and 30, the remaining claims were not considered. If the application is determined not to be in a condition for allowance after considering this amendment in conjunction with the previous claim amendments, the Applicants respectfully request that the next Office Action be made non-final.

Claim Rejections – 35 U.S.C. §102 and 35 U.S.C. §103

Accordingly, since the same claim rejections in this Office Action are identical to those in the last Office Action even though claims were amended and no new issues were raised, Applicants' previous arguments apply. The examiner cited *in re Keller* to show that one cannot attack references individually when a rejection is based on a combination. The reason why each reference was discussed was to show their principle of operation and the lack of motivation to combine their teachings.

Mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. It must be explained why one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious. Applicants' arguments stress the lack of motivation-suggestion-teaching. Rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Lee*.

The arguments presented in the May 22, 2006 amendment went into great detail regarding the lack of motivation to combine the individual references. The July 28, 2006 Amendment Accompanying RCE, in conjunction with the four claim amendments, also goes to what the references teach and the lack of motivation to combine the references.


A check in the amount of \$120.00 is enclosed for a one month extension of time. Should the Director determine that an additional fee is due, he is hereby authorized to charge said fee to Deposit Account No. 21-0279.

If the Examiner believes that a further telephonic interview will facilitate allowance of the claims, she is respectfully requested to contact the undersigned at 203-777-2268.

Accordingly, Applicants submit that claims 1-17, 19-27, 29-31, 33-40 and 42-45 are in condition for allowance.

Please charge any fees or deficiency or credit any overpayment to our Deposit Account of record.

Respectfully submitted,

By 
Timothy Lubecki
Attorney for Applicant
Reg. No.: 38,953

Telephone: 203-777-6628

Telefax: 203-865-0297

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I, Rhonda B. Longo, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on January 17, 2007.

